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Hearing:

June 1, 2000

11/8/00

Paper No. 17

JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CAT Scale Company

Serial No. 75/344,221

Wendy K. Marsh of Zarley, McKee, Thomte, Voorhees & Sease
for **applicant**.

Barney L. Charlton, Trademark Examining Attorney, Law
Office **105** (Thomas G Howell, Managing Attorney).

Before Quinn, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by CAT Scale Company to
register the mark CERTIFIED AUTOMATED TRUCK SCALE for
services identified as "truck weighing."¹ Applicant claims,
pursuant to Section 2(f) of the Trademark Act, that its
mark has acquired distinctiveness.

The Trademark Examining Attorney has refused

¹ Application Serial No. 75/344,221, filed August 20, 1997,
alleging dates of first use of 1985.

registration under Section 2(e)(1) of the Trademark Act on the ground that CERTIFIED AUTOMATED TRUCK SCALE, when used in connection with truck weighing services, is highly descriptive and, accordingly, that the evidence of acquired distinctiveness submitted by applicant is insufficient to permit registration on the Principal Register.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs,² and both appeared at an oral hearing.

The Examining Attorney maintains that the mark sought to be registered is highly descriptive and that, in view thereof, the evidence of acquired distinctiveness is insufficient for registration.³ The Examining Attorney contends that the mark directly describes a feature or characteristic of applicant's services. More specifically, the Examining Attorney asserts that applicant's services are rendered by way of a truck scale which is automated and

² The Examining Attorney, in his brief, requests the Board to take judicial notice of a registration owned by applicant for a different mark covering services identified as "truck weighing service on certified automated truck scale." Applicant, in its reply brief, has objected to the introduction of this evidence. The Board does not take judicial notice of registrations issued by the Office and, accordingly, the registration has not been considered. See also: Trademark Rule 2.142(d).

³ So as to be clear on this point, the issue is not genericness. This was reiterated by the Examining Attorney at the oral hearing, and is reflected by the prosecution history.

which is certified by state authorities. In support of the refusal, the Examining Attorney submitted dictionary definitions of the words comprising applicant's mark. Also of record are excerpts retrieved from the NEXIS database, as well as excerpts pulled off the Internet. These materials show, according to the Examining Attorney, that terms such as "certified truck scale" and "automated truck scale" are commonly used in the trade in connection with truck weighing services.

Applicant argues that it has provided sufficient evidence to demonstrate that the relevant class of users associates the mark sought to be registered with services rendered by applicant. Applicant points to the specific evidence of record, including over 14 years of continuous use of the mark, annual advertising expenditures exceeding \$1 million, and the annual distribution through 650 nationwide locations of more than 3 million scale tickets bearing the mark. The specific facts relied upon by applicant appear in three declarations.

A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature,

function, purpose, or use of the goods or services. See: In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). As to acquired distinctiveness, applicant has the burden of proof to establish a prima facie case of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Applicant submitted the declarations of Delia Moon Meier, applicant's senior vice president. Ms. Meier attests to applicant's substantially exclusive and continuous use of its mark in connection with truck weighing services since 1985. Ms. Meier also states that applicant spends over \$1 million per year advertising the services under the mark, that applicant distributes more than 3 million scale tickets to its customers each year, and that every single one of applicant's customers receives a scale ticket with the mark appearing thereon.

Also of record is the declaration of Heather DeBaillie, applicant's advertising and promotions director. Ms. DeBaillie states that the more than 3 million scale tickets are distributed through applicant's 650 locations, and that the mark sought to be registered has appeared on

the scale tickets in a "conspicuous manner" since at least as early as 1988. Ms. DeBaillie also asserts that the primary customers for applicant's services are semi-truck drivers hauling heavy loads who weigh their trucks to avoid fines from state-operated weigh stations. Included in the declaration are the results of surveys of approximately 5,000 drivers who are customers of applicant's services. The results show that about 75% of the drivers use applicant's services at least 6 times each month. Applicant points to the results as evidence of "the great frequency with which each one of applicant's customers see and associate the mark CERTIFIED AUTOMATED TRUCK SCALE with applicant's truck weighing services."

The dictionary evidence shows the following meanings: "certify: to attest as being true or as represented or as meeting a standard;" "automate: to operate by automation, to convert to largely automatic operation;" "truck: a wheeled vehicle for moving heavy articles;" and "scale: an instrument or machine for weighing." *Webster's New Collegiate Dictionary* (1979).

The Examining Attorney also submitted NEXIS® materials showing several uses of "certified truck scale" and "automated truck scale" in connection with the type of scale used in rendering applicant's services. Examples of

the uses include the following: "[o]ther draws for truckers are computerized certified truck scales..." *The Fresno Bee*, October 3, 1994; "[o]n the stop's sprawling grounds, where the rumble and fumes from the diesel rigs fill the air, are a service garage, certified truck scale, gas and diesel pumps, and a parking lot that will handle 110 rigs." *Chicago Tribune*, April 10, 1994; and "[I]t now includes automated truck scales..." *Coal Age*, December 1996.

The Examining Attorney also submitted Internet evidence showing uses by third parties on their Web pages of "automated truck scale" in connection with their scales and related services. An excerpt from applicant's Web page indicates that applicant's "scales are certified in the state they are located in."

Applicant does not dispute the mere descriptiveness of the matter sought to be registered. Indeed, based on the record before us, we are persuaded that the term CERTIFIED AUTOMATED TRUCK SCALE is not just merely descriptive, but rather that the term is highly descriptive when used in connection with truck weighing services. The common meanings of the terms comprising the mark, coupled with the evidence showing third-party uses of the terms "certified truck scale" and "automated truck scale," establish that

CERTIFIED AUTOMATED TRUCK SCALE, when considered as a whole, is highly descriptive as used in connection with truck weighing services.⁴ The term merely describes truck weighing services rendered through the use of automated truck scales that are certified in the states in which the scales are located.

We turn then to the question of whether CERTIFIED AUTOMATED TRUCK SCALE has become distinctive of applicant's services in commerce. We recognize that applicant's continuous use dates back to 1985. Further, we acknowledge that applicant's distribution of over three million scale tickets at 650 locations would suggest that applicant has enjoyed a degree of success and that the term sought to be registered has been exposed to many truckers.⁵ And, according to applicant's surveys, a high percentage of these truckers are frequent customers of applicant's services. Nonetheless, this evidence demonstrates only the popularity of applicant's truck weighing services, not that the relevant purchasers of such services have come to view

⁴ In this connection, we do not share applicant's view that the Examining Attorney improperly dissected the mark. Lest there be any doubt, we reiterate that, in determining the registrability of the mark, we have considered applicant's mark as a whole.

⁵ The record does not include any sales figures relating to applicant's services under the mark.

CERTIFIED AUTOMATED TRUCK SCALE as applicant's source-identifying service mark. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and In re Recorded Books Inc., 42 USPQ2d 1275 (TTAB 1997). Similarly, applicant's promotional expenditures do not, in and of themselves, lead us to infer that the publicity has been effective in creating distinctiveness. The issue here is the achievement of distinctiveness, and not the effort expended in the attempted achievement. In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). See also: In re Andes Candies Inc., 478 F.2d 1264, 178 USPQ 156 (CCPA 1973).

Applicant points to the weight scale ticket as being the "single, most effective way possible for applicant to establish a connection between its mark and applicant's truck weighing services with the relevant consumers, namely truck drivers" given that more than 3 million have been distributed. (brief, pp. 8-9) Although the matter sought to be registered is displayed in a prominent manner on the ticket, the ticket also shows the conspicuous CAT logo mark. In point of fact, applicant's promotional brochures advises truckers as follows: "Not all truck stop scales can be CAT Scales. Look for the gold and black sign and the CAT logo on the weight ticket to be sure." Thus, it

would appear that no particular effort has been made by applicant to specifically promote the term CERTIFIED AUTOMATED TRUCK SCALE as a source indicator, but rather has pointed to other indicia.

To be clear on this significant point, we emphasize that the record is completely devoid of **direct** evidence that the relevant class of purchasers, semi-truck drivers with heavy loads, views CERTIFIED AUTOMATED TRUCK SCALE as a distinctive source indicator for applicant's services.

Given the highly descriptive nature of the term CERTIFIED AUTOMATED TRUCK SCALE, we would need to see a great deal more evidence (especially in the form of direct evidence from truckers) than what applicant has submitted in order to find that the term has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. *Yamaha Int'l. Corp. v. Hoshino Gakki Co.*, supra. See also: *Restatement (Third) of Unfair Competition* (1993), Section 13, comment e:

The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less

descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness.

Decision: The refusal to register is affirmed.

T. J. Quinn

C. E. Walters

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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